

## REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-20 and 23.

The following claims are *independent*: 1, 16 and 20.

The following claims have previously been *cancelled* without prejudice or disclaimer: 21 and 22.

Please *add* new claim 23, and *amend* claims 1, 4, 11, 13, 16 and 20; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new, amended claims are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

### **Claim Rejections - 35 U.S.C. § 103**

The Office Action rejected claims 1-3, 5-11, 14 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stewart et al., U.S. Publication No. 2003/0135457 (hereinafter "Stewart"), in view of "Business credit: the revolution in online credit resources" by Fay Hansen in Business Credit, October 2000 (hereinafter "Hansen"). Moreover, the

Office Action rejected claims 4 and 16-19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stewart in view of Hansen, and further in view of Greene et al., U.S. Publication No. 2002/0143686 A1 (hereinafter “Greene”). Lastly, the Office Action rejected claims 12, 13 and 15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stewart and Hansen as applied to claim 1 above, and further in view of Dictionary of Economics by Wiley (1995) from [www.xreferplus.com](http://www.xreferplus.com) (hereinafter “Xreferplus”).

Although Applicant continues to traverse the Examiner's rejection and submits the claims are patentably distinct for at least the reasons discussed in the Amendment and Response dated February 10, 2009, Applicant submits the amended claims are patentable over the cited references for at least the reasons noted in this Amendment/Response.

Moreover, Greene was filed on March 9, 2001, less than six months earlier than Applicant's filing date of March 20, 2001. Therefore, it is not conceded that Greene was filed in the US before the invention by the Applicant. Without so conceding, Applicant respectfully traverses the Examiner's rejection.

### **Requirements to Establish Prima Facie Obviousness**

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.”

*Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*<sup>1</sup>, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements (A) and (B), and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

<sup>1</sup> The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

### Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element as recited, *inter alia*, in currently amended independent claim 1:

A computer implemented method to manage risk related to opening a client account, the method comprising:  
... receiving client corporate structure data elements relating to a client seeking to open the client account, with an **assigned numerical risk level value** for each data element, into a computer system, each assigned numerical risk level value **representing relative risk potential**;  
;.... (Emphasis added).

The Office Action admits, "Stewart does not specifically disclose client corporate structure data elements with a corresponding risk level for each," and relies on Hansen to make up for this deficiency, "Hansen discloses client corporate structure data elements with a corresponding risk level for each (page 1, sections 1-2; page 2, sections 1-3, 6 and 9; page 3, section 7; page 4, section 8)." (Office Action, page 3). Applicant respectfully disagrees with these assertions and submits the Office Action mischaracterized Hansen.

Contrary to the Office Action's assertions, Applicant submits that Hansen discusses credit-related information provided in a report or a database. For example, Applicant notes that Hansen discusses, "standard credit-related information such as company background, officers and executives, ownership, financial information, public filing information, antecedent information and business news report[s]...", but does not even arguably teach or suggest that, for example, the ownership information or public filing information has an numerical risk level value which is assigned by the system and representing a relative risk potential. (Hansen, page 1, section 2). Further, Applicant notes that Hansen lists,

"[i]nformation provided in... business reports include company profile and contact information; line of business; ownership; a credit or stability rating based on businessCreditUSA.com's own model and data; parent company; public filing information...; a management directory, news items; revenues....," but nowhere does it suggest that each item (or even most items) of such information has an assigned numerical risk level value. (Hansen, page 2, section 3). Applicant also notes that Hansen discusses, "Each report includes financials, key quarterly operating issues, publicly traded debt instruments, borrowing ability and restrictive covenants, major debt service requirements, and expert analysis," but, again, nowhere does Hansen suggest or teach such information having assigned numerical risk level values representing a relative risk potential. (Hansen, page 2, section 3).

Therefore, Hansen does not teach or suggest at least the claimed, "receiving client corporate structure data elements relating to a client seeking to open the client account, with an **assigned numerical risk level value** for each data element, into a computer system, each assigned numerical risk level value **representing relative risk potential**," as recited in currently amended claim 1.

The Office Action asserts, "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the use of scoring risk for new accounts for individuals as disclosed by Stewart to adapt the scoring of risk for companies as disclosed by Hansen." (Office Action, pages 3-4).

Similarly, on page 17 of the Office Action, the Examiner asserts,

In addressing the disputed matter of 'reputational risk'... it would be obvious to one of ordinary skill in the art that reputation risk related to one's professional standing would be a factor in making the determination of opening an account. This is simply common sense. Again as stated above in rejection, if a client were known in the industry to commit white-collar crimes and to have embezzled funds through a previous account, a higher reputational risk would be placed on that client and it would be less likely that a fellow banker would open an account for that individual.... The practice of knowing industry colleagues' reputations, and making decisions using that information, is an old and well known practice.

Applicant respectfully disagrees with the Examiner's assertions and submits that the pending rejection has merely provided conclusory statements which are unsupported by any documentary or other evidence.

To properly support such an assertion, the Examiner must: (a) provide evidentiary support (MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill."); (b) establish the appropriate indication of ordinary skill in the art (MPEP § 2141 (II)(C)); and (c) provide an objective rationale for modifying and/or using the applied references and/or the official notice (MPEP §2141 (III) ), making all such assessments without impermissible hindsight, picking and choosing, mischaracterizations and over-generalizations.

(a). Evidentiary Support. Applicant submits that the Examiner fails to provide explicit evidentiary support as to why the element in the prior art reference would be considered a claim element of the noted claims.

(b). Indication of the level of ordinary skill. In addition to the aforementioned lack of evidentiary support, Applicant further submits that impermissible hindsight has been applied

in asserting obviousness of the various claim elements without citing prior art or providing an indication of the level of ordinary skill. The pending rejection, for example, asserts “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the use of scoring risk for new accounts for individuals...,” (Office Action, pages 3-4) but has provided no indication or discussion of the level of ordinary skill associated therewith. The rejection's reference to “skilled in the art” is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” Applicant is unclear as to what exactly the Examiner is alleging with regard to the level of ordinary skill and, thus, is not in a position to provide a complete reply that is most suited to addressing the Examiner's concerns. As no indication of the level of ordinary skill has been provided, Applicant submits that the rejection applies impermissible hindsight in the guise of “common sense” and has not made a prima facie showing of obviousness. Should the Examiner maintain the rejection, Applicant respectfully requests that she identifies the pertinent art, discusses the level of ordinary skill alleged to be associated therewith at the time of the invention, and clarifies why she believes the claimed subject matter would have been obvious to one possessing that level of skill.

(c). Objective Rationale. By way of example only, Applicant notes that the pending rejection alleges, “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the use of scoring risk for new accounts for individuals...” (Office Action, pages 3-4).

Applicant respectfully submits that the alleged rationales for the proposed modifications of the applied references provided here and throughout the pending rejection are overly general and do not point beyond Stewart to a modification of itself or a combination with the allegedly obvious “scoring risk.” Applicant is unclear how the Examiner believes it is obvious to one of ordinary skill in the art to modify the general alleged utility stated in Stewart merely to “adapt the scoring of risk for companies.” Applicant submits that merely citing an alleged utility of a reference’s own system, without providing any attendant explanation or articulation of how that alleged utility points beyond the reference to the modifications of the references proposed in the pending rejection, is insufficient to support an assertion of obviousness under 35 U.S.C. § 103.

Similarly, Applicant submits that Greene's "online trading system" and Xreferplus' "weighted average" fail to remedy the deficiencies identified above in Stewart with regard to amended independent claim 1. For at least the reasons discussed above, Applicant submits that the pending rejection has not established a *prima facie* case of obviousness for, at least, the amended claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

Although of different scope than independent claim 1, Applicant submits claims 16 and 20 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action’s application of Stewart with regard to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.



## CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited references, pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office actions) (hereinafter “Office Actions”). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse or distinguish over any such remaining bases for rejection at a later time, should it become necessary.

Further, any remarks that were made in response to the Office Actions’ objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Actions objections and/or rejections as to any other claim element(s), any such re-assertions of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claims as a whole, and no such commonality is admitted as a consequence of any such re-assertions of remarks.

Consequently, the references cited the Office Actions do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the references are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any Official Notice that has been taken and/or (mis)characterizations of claims made in the Office Action(s). As such, Applicant does not

concede that any claim elements have been anticipated and/or rendered obvious by any of the cited references and/or any Official Notice in the Office Actions.

Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-20, all: overcome all rejections and/or objections as noted in the Office Actions, are patentable over and distinguished from the cited references, and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and/or objections, and allowance of all claims.

### **Authorization**

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-449. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-449.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,  
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